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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,434	11/13/2001	Randhir P.S. Thakur	1450.001US1	3036
21186 7590 07/18/2007 SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER CASLER, TRACI	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 07/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/008,434

Applicant(s)

THAKUR, RANDHIR P.S.

Examiner

Traci L. Casler

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is in response to papers filed on April 30, 2007.
2. Claims 32-33 have been added.
3. Claims 1-33 are pending.
4. Claims 1-33 are rejected.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. Claims 1, 11, 22, 29 and 32-33 all contain the limitation of evaluating the invention. The examiner notes that the disclosure discusses that an invention can be evaluated on based on it's patentability, it's legal aspects it's commercial viability and technical aspect. However, the disclosure fails to teach on one would evaluate the submitted invention information for these aspects. The disclosure mentions it

represents human or automated activities. This begs the question of how is the evaluation "module" of the system claims accomplished. Furthermore, what steps do humans take in order to evaluate the invention. What is the basis of the evaluation?

***Claim Rejections - 35 USC § 103***

8. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 20020032659 A1 Waters; System and Method for Obtaining and Developing Technology for Market in view of US Patent 6298327 Hunter et al; Expert Support System for Authoring Invention Disclosures.

9.

10. s to claims 1, 11, 22, 29 and 31-33 Waters teaches:

Receiving information regarding inventive ideas(Pg. 3 ¶ 6).

Evaluating invention potential(Pg. 3 ¶ 19).

Providing database of information to potential costumers of inventions(Pg. 3 ¶ 19).

11. However, Waters fails to teach "classifying" the inventions into class/subclass and "technical categories. Hunter teaches classifying the inventions according to the USPTO classification schedule(C. 12 I. 24-27). It would have been obvious to one skilled in the art at the time of invention to combine Hunter with Waters as by classifying the invention this will assist in prior art identification helping establish any legal or commercial viability.

12. As to claims 2, 12 and 23 Waters teaches the evaluation as prior art searches (Pg. 3 ¶ 19).
13. As to claims 3, 13 and 26 Waters teaches the computer processing controlling the interactions between users(Pg. 3 ¶18).
14. As to claims 4, 15 and 24 Waters being possibilities for funding(Pg. 5 ¶31).
15. As to claims 9 and 17 Waters teaches indicating current patent art pertaining to invention(Pg. 4 ¶24).
16. As to claims 10 and 18 Waters teaches controlling access to the customers(Pg. 5 ¶30).
17. As to claims 7, 20 and 27 Waters teaches paying inventor royalties(Pg. 5 ¶30).
18. As to claim 14 Waters teaches anonymity between users(Pg. 3 ¶17).
19. As to claim 16 Waters teaches refining invention after initial evaluation(Pg. 4 ¶21).
20. As to claim 25 Waters teaches experts(humans) reviewing inventions(Pg. 3 ¶ 19). The examiner notes that this limitation, although taught by the prior art, is considered intended use. By having a human perform functions of the process is merely how applicant intends to use the process.
21. As to claim 30 Waters teaches a company running the databases.(Pg. 4 ¶ 26).
22. Claims 8, 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 20020032659 A1 Waters in view of US Patent 6298327 Hunter et al; Expert

Support System for Authoring Invention Disclosures as applied to claims 1-7, 9-20, 22-27 and 29-33 .

23. As to claims 8, 21 and 28 Waters teaches a information disclosure process and disclosure review. However, Waters and Hunter fail to teach translating information into the desired languages. It would have been obvious to one of skill in the art at the time of invention to combine this limitation with Waters so as to not limit the type or nationality of costumers who may be interested in funding an invention.

### ***Response to Arguments***

24. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

25. As all applications arguments are drawn to the aspect of "classification" the examiner notes the arguments have been address previously in the above rejection therefore the arguments are moot.

### ***Conclusion***

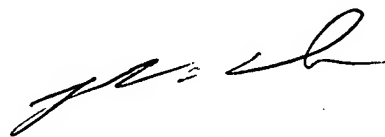
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLC  


  
JOHN WEISS  
SUPERVISOR, EXAMINER  
ART UNIT 3629